



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/715,872

11/15/2000

Michael Bleser

29488/36478

7661

4743

7590

09/12/2005

MARSHALL, GERSTEIN & BORUN LLP  
233 S. WACKER DRIVE, SUITE 6300  
SEARS TOWER  
CHICAGO, IL 60606

EXAMINER

PORTER, RACHEL L

ART UNIT

PAPER NUMBER

3626

DATE MAILED: 09/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/715,872

Applicant(s)

BLESER ET AL.

Examiner

Rachel L. Porter

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This communication is in response to the amendment filed 6/15/05. Claims 1-16 are pending.

#### ***Election/Restrictions***

2. Applicant's election with traverse of Group II in the reply filed on 6/15/05 is acknowledged. The traversal is on the ground(s) that there is no serious burden on the examiner to examine both groups at this time, and that the two claimed inventions are not patentable distinct (novel or unobvious) over each other. The Examiner has found Applicant's arguments to be persuasive.

The restriction is hereby withdrawn, and claims 1-16 will be examined on the merits.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-8 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites that the "application server is configured to allow each of the one or more customers to access information concerning drugs and personal information of

Art Unit: 3626

each respective customer of the one or more customers..." It is unclear to the Examiner from the claim language whether the customer is able to access only his/her information or whether he/she may access every customer's information. Furthermore the use of the language such as "configured to," and "adapted to" makes it unclear whether a particular function (or particular functions) is actually carried out by the recited hardware.

Also, claim 1 further recites that application server "enable[s] each of the one or more customer to transmit a prescription order to either at least one of the plurality of member pharmacies or one of the one or more shipping facilities or both, so that at least one prescription drug associated with the prescription order is shipped from the one of the one or more shipping facilities." It is unclear to the Examiner whether the Applicant which alternatives the applicant intends to encompass in the current claim language. The use of "at least one of" does not preclude orders being transmitted to both of the listed options (i.e. orders being transmitted to both a pharmacy and a shipping facility). Therefore, it is unclear why the Applicant has used the terms "either/or", "at least one of", and "both" in describing the facilities to which orders may be transmitted. Furthermore, the "so"-clause (an intended use phrase) seems to contradict the alternative language set forth in the earlier part of the claim by indicating that all prescription orders must originate from (i.e. be transmitted to a shipping facility).

Finally, it is unclear from the claim language whether the customer is a physician/health care professional/pharmacist ordering on behalf of his patients or if the

Art Unit: 3626

applicant intends to include patients and healthcare professionals in the disclosed system/method.

Claims 2-8 inherit the deficiencies of claim 1 through dependency and are also rejected.

Claim 14 recites "manually entering at least one of customer contact information, a username, a password, and a customer profile information..." However, the last step of the claim recite that information is communicated to the user using *the customer contact information*. There is insufficient antecedent basis for this limitation in the claim. In particular, the current claim language does not require that contact information be entered for the customer, insofar as the limitation recites that "at least one of..." the listed limitations must be entered. It is therefore unclear to the Examiner which data is required in the manual entry step.

Also, it is unclear to the Examiner which data are being "associated" with one another in the associating step.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 3626

6. Claims 1-9, 11-12, and 15-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Szabo (USPN 5,954,640).

[Claim 1] Szabo teaches a system for accessing pharmacy data and ordering prescriptions via a network comprising:

- a network server connected to the network that is accessible by one or more customers via the network; (Figure 1; Web server (10))
- an application server connected to the network server; (Figure 1, Application server (15))
- a database connected to the application server, the database containing information concerning drugs and personal information concerning one or more of the customers; and (Figure 1; database 11-14)
- an intranet server that is connected to at least a plurality of member pharmacies and one or more shipping facilities, the intranet server being connected to the application server; (col. 10, lines 51-62)
- wherein the application server is configured to allow each of the one or more customers to access the information concerning drugs and personal information concerning each respective customer of the one or more customers and enable each of the one or more customers to transmit a prescription order to either at least one of the plurality of member pharmacies or one of the one or more shipping facilities (Figure 1; col. 8, lines 5-19; col. 12, lines 51-62; col. 13, lines 30-37—  
Application server performs optimization, allows user to evaluate a proposed

purchase on a health optimization, and helps link patient to purchasing system for order placement.)

[Claim 2] Szabo the system as defined in claim 1, wherein the network server displays one or more interactive webpages to the one or more customers that is viewable by the one or more customers with a respective network browser. (col. 6, lines 26-40; col. 11, lines 31-37; col. 12, lines 28-44).

[Claim 3] Szabo teaches a system wherein the personal information concerning the one or more customers includes a prescription history of each respective one of the one or more customers. (col. 7, lines 62-col. 8, line 4)

[Claim 4] Szabo teaches the system as defined in claim 3, wherein the network server is configured to format display of the prescription history of each respective one of the one or more customers according to a plurality of selectable display formats that are selected by the respective one of the one or more customers. (Figure 3; col. 6, lines 26-35; col. 12, lines 35-61)

[Claim 5] Szabo teaches system wherein the network server is configured to allow each respective one of the one or more customers to print each particular selectable display format of the prescription history that is selected by the respective one or the one or more customers. (col. 6, lines 43-47; col. 12, lines 35-61)

Art Unit: 3626

[Claim 6] Szabo teaches a system wherein the network is the Internet. (col. 13, lines 37-42)

[Claim 7] Szabo teaches a system wherein access to personal information concerning each respective customer of the one or more customers includes at least one of access and viewing of the personal information, editing of the personal information and adding additional information to the personal information previously stored.

[Claim 8] Szabo teaches a system as defined in claim 1, wherein the prescription order includes at least one of ordering a new prescription (i.e. recommendation from the optimization), or refilling an existing prescription. (col. 15, lines 5-14; col. 16, lines 27-39)

[Claim 9] Szabo teaches method enabling one or more customers to order prescriptions and access pharmacy data via a network comprising the steps of:

- accessing a network server hosting a network website via the network; (Figures 1-2)
- registering a customer with the network website; (Figure 2; col. 13, lines 43-67)
- displaying to the customer on the website at least one of a prescription order selection and a pharmacy data access selection; (col. 14, lines 11-16; col. 15, lines 5-14)
- displaying one or more prescription order displays to the customer on the website when the customer selects the prescription order selection wherein the customer is



Art Unit: 3626

allowed to select to transmit a particular prescription order to a communication network that connects at least one of a plurality of member pharmacies and one or more distribution facilities; and (col. 10, lines 51-62; col. 16, lines 8-14)

- displaying one or more pharmacy data access displays to the customer when the customer selects the pharmacy data access selection wherein the customer is allowed to access one of a personal prescription history and specific drug information from a database. (col. 16, lines 16-26)

[Claim 11] Szabo teaches a method, wherein the personal prescription history includes one or more of current prescriptions and past prescriptions (col. 13, lines 44-67; col. 16, lines 15-26—e.g. medical conditions and treatments)

[Claim 12] Szabo teaches a method as defined in claim 9, wherein the particular prescription order includes one of a new prescription order or a refill of an existing prescription. (col. 15, lines 5-14; col. 16, lines 27-39)

[Claim 15] Szabo teaches a method further comprising the steps of:

- enabling the customer to select one or more display formats for the personal prescription history; and (Figure 3; col. 6, lines 26-35; col. 12, lines 35-61)
- enabling a customer to print a specific format selected by the customer from the one or more display formats. (col. 6, lines 43-47; col. 12, lines 35-61)

[Claim 16] Szabo teaches a method wherein the particular prescription order includes a selectable designation by the customer to communicate that the prescription will one of a) be manually picked up at a selected pharmacy store location; and b) be shipped to a designated postal address. (col. 6, lines 47-56; col. 10, lines 51-62; col. 15, lines 5-14—System allows the prescribed treatment to be purchased a retail facility (i.e. pharmacy store location or through the mail. )

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Szabo as applied to claim 9, and in further view of Mayaud (USPN 5,845,255 A).

[Claim 10] Szabo teaches a prescription ordering method including the step of registering customers as explained in the rejection of claim 9. Szabo further discloses a method wherein the step of registering the customer further comprises the steps of:

- prompting the customer to enter a username and personal profile information; (col. 13, lines 43-67)

Art Unit: 3626

- transmitting and storing an entered username and personal profile information to/in a network server; (Figure 1—personal storage database ; col. 13, lines 30-37)
- enabling the customer to access at least portions of the website by subsequent entry of the entered username (Figure 3; col. 16, lines 15-39)

Szabo discloses the method above, but does not expressly disclose the use of passwords as part of the user access system. Mayaud discloses a prescription creation/file access system wherein the individuals submitting prescriptions and accessing the patient profiles use passwords (col. 10, lines 12-51). At the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method of Szabo with the teaching of Mayaud to include the use of passwords to access profiles and/or submit prescriptions. As suggested by Mayaud, one would have been motivated to include this feature to further protect sensitive patient information, (col. 10, lines 24-27) and to provide an audit trail of individuals accessing the system (col. 18, lines 62-65)

9. Claim 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Szabo as applied to claim 9, and in further view of Official Notice.

[Claim 13] Szabo teaches a method as defined in claim 9 as explained in the rejection of claim 9. Szabo further discloses a method requiring the use of personal profile information and other identifying information to access the system, but does not expressly disclose the use of PIN numbers to access to access the system. However, it

Art Unit: 3626

is noted that the use of generated PIN numbers or personal codes as a security measure to access a system (e.g. website, telephone system) is old and well known in the art. At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method Szabo to include the use of generated PIN numbers to access secured portions of the site. One would have been motivated to include this feature to further protect sensitive patient information and minimize fraudulent charges made against the customer.

[Claim 14] Szabo teaches a method as defined in claim 9, wherein the step of registering the customer further comprises:

- manually entering a username and a customer personal profile concerning the customer into a connection to an intranet server located in one of any one of a plurality of member pharmacies and one or more centralized company locations; (col. 6, lines 12-25)
- associating the customer in a network server and information concerning the customer currently stored to a database from the intranet server; and (col. 6, lines 26-35)

Szabo discloses the method as disclosed above, but does not disclose the step of communicating at least a username and password, which enable the customer to access the network website, to the user via a secured communication. (See 112, 2<sup>nd</sup>)

However, it is noted that confirmation messages providing registered users with information on the username and secondary identification information (e.g. password or

Art Unit: 3626

PIN's) are old and well known in the art. At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method of Szabo to provide confirmation messages to registered users, including their username and secondary identifying information (i.e. password/ PIN). One would have been motivated to include this information to ensure that the customer has properly registered for the system and to facilitate his/her access to the system.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel L. Porter whose telephone number is (571) 272-6775. The examiner can normally be reached on M-F, 9:30-6:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 09/715,872  
Art Unit: 3626

Page 13

RP  
RP

  
JOSEPH THOMAS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600